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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,701	01/06/2005	Hidetaka Oka	EL/2-22711/A/CGJ 128/PCT	2587
324	7590	09/25/2006	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			VISCONTI, GERALDINA	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/520,701

Applicant(s)

OKA ET AL.

Examiner

Geraldina Visconti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

*Geraldina Visconti*  
Geraldina Visconti  
Primary Examiner  
Au 1752

This office action is responsive to the Amendment filed July 24, 2006. Claim 8 has been canceled. Claims 1-7, 9 and 10 are pending and presently under consideration in this application.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elzer et al. (U.S. Patent No. 4,725,524) in view of either Burri (U.S. Patent No. 4,154,463) or Iwasaki et al. (U.S. Patent No. 4,598,036), for the reasons of record.

Elzer et al. discloses a process for preparing a dry film resist, which process comprises forming a photocurable resin composition onto a support film with a thickness of 1 to 50 $\mu$ m and optionally laminate a protective film onto the photocurable composition layer to obtain a dry film resist; whereby the photocurable resin is formed from a homogeneous mixture comprising (a) from 20-90 wt % of an alkaline soluble binder oligomer or polymer; (b) from 5 to 60 wt % of one or more photopolymerizable monomers which are compatible with the oligomers and polymers of component (a); (c) from 0.01 to 20% by weight of one or more photoinitiators; and (d) from 0 to 20% by weight of additives and/or assistants, wherein the total of the wt% of (a) to (d) is 100% by weight. Although Elzer et al. does not disclose the leuco triphenylmethane dye of the

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instant formula I, the use of the leuco triphenylmethane dye of the instant formula I as a color former in film resists as well known in the art, as illustrated in each of Burri and Iwasaki et al. It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to incorporate a leuco triphenylmethane dye of the instant formula I into the dry film resist of Elzer et al. as component (d) therein, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those associated with the use of the leuco triphenylmethane compound.

Please refer to the following paragraph 3.

### ***Response to Arguments***

3. Applicant's arguments filed July 24, 2006 have been fully considered but they are not persuasive. Applicants refer to the experimental data herein the specification as an illustration of the unexpected results achieved with the present invention. However, the experiments herein the specification use only leuco crystal violet as the comparative dye. The primary reference, i.e., Elzer et al. (U.S. Patent No. 4,725,524), does not utilize leuco crystal violet. Therefore the data herein the specification fails to provide a direct comparison with the closest prior art of record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldina Visconti whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Geraldina Visconti  
Primary Examiner  
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